

REMARKS

Claims 1-3 and 5-39 are pending in this application. Claim 4 was canceled in a previous response and claims 2, 3, and 8-35 are withdrawn from consideration as being directed to non-elected inventions. Accordingly, claims 2, 3, and 8-35 are canceled by this amendment. New claims 40-43 are added, which are supported by the specification at Fig. 1; p. 6, lns. 18-29; p. 8, lns. 6-12; p. 23, lns. 4-8; and p. 24, lns. 4-14. Upon entry of these amendments, claims 1, 5-7, and 36-43 will be pending in this application.

Editorial Corrections

To correct a typographical error, claim 36 is amended to recite “PEGMME” instead of “PEGME,” as supported in the specification, *inter alia*, at p. 7, ln. 3.

Specification

In response to Examiner’s objection, the embedded hyperlink on p. 4, ln. 20 has been removed.

Claim Objections

Claims 1, 5-7, and 36-39 were objected to for improper grammar. As suggested by the Examiner, “A” has been inserted at the beginning of claims 1, 7, 36, and 39, and “The” has been inserted at the beginning of claims 5, 6, 37, and 38.

Rejections for New Matter

Claims 36-39 were rejected under § 112, first paragraph, for containing new subject matter not supported by original claim 8. This rejection is overcome by amendment of claim 36 to include all the limitations of original claim 8. Specifically, claim 36 now recites that the PEG or PEGMME has a “concentration of 5-30 wt %” and the buffer agent has a “concentration such that pH 6.0-9.0 is provided.” Applicants submit that claims 36-39 are now sufficiently supported by the disclosure contained in original claim 8 and respectfully request withdrawal of these rejections.

Rejections for Lack of Written Description

Claims 36-39 were rejected under § 112, first paragraph, for lack of written description of the claimed genus of crystals. This rejection is overcome by amendment of claim 36 to recite the specific unit cell dimensions of the crystal, as provided in the specification at p. 6, lns. 1-29.

Applicants submit that claims 36-39 are now in compliance with the written description requirement and respectfully request withdrawal of these rejections.

Rejections for Lack of Enablement

Claims 1 and 5-7 were rejected under § 112, first paragraph, as being non-enabled by the specification. Applicants submit a declaration under Rule 132 as evidence that the disclosure, as filed, was enabling for SEQ ID NO: 2 as recited in claims 1 and 5-7. The declaration describes an experiment showing that the claimed invention works for SEQ ID NO: 2.

The requirement that the disclosure be enabling at the time of filing “does not preclude applicant from providing a declaration after the filing date which demonstrates that the claimed invention works.” *See* M.P.E.P. § 2164.05. In such instances, the M.P.E.P. requires that “the examiner should carefully compare the steps, materials, and conditions used in the experiments of the declaration with those disclosed in the application to make sure that they are commensurate in scope; i.e., that the experiments used the guidance in the specification as filed and what was well known to one of skill in the art.” *See id.*

The experiment described in the declaration successfully crystallized a decarbamylase of SEQ ID NO: 2 using the identical steps, materials, and conditions as used to crystallize SEQ ID NO: 1, with only two exceptions: PEGMME is used instead of PEG, and magnesium chloride is used instead of lithium chloride. However, the specification at p. 14, lns. 7-14 and p. 15, lns. 4-13 discloses that either PEG or PEGMME could be used as a precipitating agent and that either sodium chloride, lithium chloride, or magnesium chloride could be used as the additive salt. Thus, by successfully using the guidance provided in the specification, the experiment referred to in the declaration demonstrates that the specification provides sufficient guidance and teachings to allow one skilled in the art to practice the invention of claims 1 and 5-7 without undue

experimentation. For at least this reason, Applicants submit that claims 1 and 5-7 are enabled by the specification and respectfully request withdrawal of the rejections.

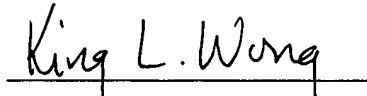
CONCLUSION

Applicants respectfully submit that the present application is now in condition for allowance. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of this application.

The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,

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